

Application No.09/687,033
Amendment Dated February 5, 2004
Reply to the Final Office Action of November 5, 2003

Remarks/Arguments

Claim 1 has been amended. No new claims have been added. No claims have been canceled. Claims 1-21 remain pending in this application. Reexamination and reconsideration of the application as amended are respectfully requested.

Rejections under 35 U.S.C. § 103(a) of Claims 1, 4, 8, 11, 15, and 18

The Examiner rejected claims 1, 4, 8, 11, 15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner et al.*, U.S. Patent No. 6,314,565 in view of *Stedman et al.*, U.S. Patent No. 6,262,726 and further in view of *Hsu*, U.S. Patent No. 5,894,515. Applicants respectfully traverse this rejection for the reasons set forth below.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), MPEP 2143.03. The prior art reference or references when combined must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), MPEP 2143.

The Examiner does not assert that any of the cited prior art or that any combination of the cited prior art teaches or suggests the third element of claims 1, 8, or 15: "determining that the

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stored user configuration corresponds to the particular user”. The Examiner does state that “Kenneth does not teach that the configuration of the application program is a user configuration, nor does he teach determining that the user configuration corresponds to the particular user.” The Examiner subsequently does not state that either *Kenner et al.*, *Stedman et al.*, *Hsu*, *Hayes, Jr.*, or any combination of these prior art references teach or suggest the third element of claims 1, 8, or 15.

Therefore, Applicants respectfully assert that the Rejection does not establish *prima facie* obviousness, and respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §103(a) rejection of claims 1, 4, 8, 11, 15, and 18.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), MPEP 2143.

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The Examiner asserts that the suggestion or motivation to modify the references or to combine the references is that "since this allows different users to access different requested software from the same machine." However, this teaching or suggestion is based upon Applicants' disclosure, not on the prior art. Applicants' disclosure specifically teaches this as one of the advantages of the invention at page 7, lines 1-2: "The present invention has the further advantage of allowing a user to be able to move between different workstations, and still be able to access the user's tools and data.". The Examiner does not assert that this teaching or suggestion is found in the prior art, and more specifically, the Examiner does not assert that this teaching or suggestion is found in either *Kenner et al.*, *Stedman et al.*, or *Hsu*. Furthermore, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), MPEP 2143.01.

Similarly, the Examiner also asserts that the suggestion or motivation to modify the references or to combine the references is that "since this allows the manifest to remain secure and only viewable by a specific user." However, this teaching or suggestion is also based upon Applicants' disclosure, not on the prior art. Applicants' disclosure specifically teaches this as one of the advantages of the invention at page 6, lines 14-15: "Another aspect of a preferred embodiment of the present invention decrypts the manifest file in response to the user authentication."; and at page 12, lines 19-21, "After the download **240** to the user's workstation **242**, the user through a local logon in the security system **246** invokes the decryption and use of

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the manifest **244** to build **248** the user's personalized application program **250**." The Examiner does not assert that this teaching or suggestion is found in the prior art, and more specifically, the Examiner does not assert that this teaching or suggestion is found in either *Kenner et al.*, *Stedman et al.*, or *Hsu*.

Therefore, Applicants respectfully assert that the Rejection does not establish prima facie obviousness, and respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. §103(a) rejection of claims 1, 4, 8, 11, 15, and 18.

Rejections under 35 U.S.C. § 103(a) of Claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21

The Examiner rejected claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner et al.*, U.S. Patent No. 6,314,565 in view of *Stedman et al.*, U.S. Patent No. 6,262,726, and further in view of *Hsu*, U.S. Patent No. 5,894,515 and *Hayes, Jr.*, U.S. Patent No. 6,205,476. Applicants respectfully traverse this rejection for the reasons set forth below.

Relative to dependent claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21, these dependent claims depend from independent claims 1, 8, and 15, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend

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from independent claims 1, 8, and 15, and Applicants believe they have successfully traversed the Examiner's rejection of independent claims 1, 8, and 15, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of dependent claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20, and 21.

Rejections under 35 U.S.C. § 103(a) of Claims 5, 12, and 19

The Examiner rejected claims 5, 12, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Kenner et al.*, U.S. Patent No. 6,314,565 in view of *Stedman et al.*, U.S. Patent No. 6,262,726, and further in view of *Hsu*, U.S. Patent No. 5,894,515 and *Misra et al.*, U.S. Patent No. 6,189,146. Applicants respectfully traverse this rejection for the reasons set forth below.

Relative to dependent claims 5, 12, and 19, these dependent claims depend from independent claims 1, 8, and 15, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since these dependent claims depend from independent claims 1, 8, and 15, and Applicants believe they have successfully traversed the Examiner's rejection of independent claims 1, 8, and 15, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of dependent claims 5, 12, and 19.


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Conclusion

Applicants therefore respectfully request that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Response is hereby solicited.

Respectfully submitted,
Howard Glaser et al.

By:


Prentiss Wayne Johnson, Reg. No. 33,123
Attorney for Applicants
International Business Machines Corporation
Intellectual Property Law
555 Bailey Avenue, J46A/G467
San Jose, CA 95141-9989
Telephone: 408.463.5673

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